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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/666,816

Filing Date: September 18, 2003

Appellant(s): KEOHANE ET AL.

James L. Baudino
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 3, 2009 appealing from the
Office action mailed March 3, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

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Claims 7-9 as being rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No. 1,087,321) in view of Milewski et al (US Pat. 5,930,471).

Claim 10 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Brogne and Milewski as applied to claim 7, and further in view of what is well known in the art.

Therefore the grounds of Rejection to be Reviewed on Appeal are as follows:

Claims 1 and 3 as being rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No. 1,087,321), hereafter "Brogne," in view of Nielsen (US Pat. 5,870,548) and in further view Milewski et al (US Pat. 5,930,471), hereafter "Milewski."

Claims 4-6 as being rejected under 35 U.S.C. 103(a) as being unpatentable over Brogne and Nielsen in view of Milewski as applied to claims 1, and further in view of what is well known in the art.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,930,471	MILEWSKI ET AL	7-1999
5,870,548	NIELSEN	2-1999

Brogne et al; EP Pub. No. 1,087,321; March 28, 2001; whole document

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No. 1,087,321), hereafter "Brogne," in view of Nielsen (US Pat. 5,870,548) and in further view Milewski et al (US Pat. 5,930,471), hereafter "Milewski,"
2. As to claim 1, Brogne discloses a method of rescinding previously transmitted e-mail messages by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of: storing an e-mail message on a computing system (column 2, lines 13-19); generating a notification message, the notification message for allowing recipients from the list of recipients to access the e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the recipients from the list of recipients (column 2, lines 15-19);

determining whether one of the recipients from the list of recipients has accessed the stored e-mail message (column 5, lines 52-54 and column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message as disclosed in column 6, lines 31-37); and

enabling the sender to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message (column 3, lines 32-41).

But, Brogne does not explicitly disclose enabling the sender *if one of the recipients from the list of recipients has accessed the stored e-mail message* to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message. That is it appears that if any one of the recipients has accessed the stored e-mail message in the Brogne teaching (see Fig. 3) a sender may not be able to preclude the other addressees from accessing the message.

However, Nielsen discloses determining whether one of the recipients from a list of recipients has accessed the stored e-mail message (column 14, lines 52-59, it is determined, on per recipient basis, whether an email

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message has been viewed and column 7, lines 12-19 acknowledges multiple recipients for a given email message); and enabling the sender if one of the recipients from the list of recipients has accessed the stored e-mail message to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message (column 14, lines 52-64, the original sender can cancel the previously sent email before a recipient views the email; as the process is done on a per recipient basis, even if another recipient has viewed the email it will not effect recipients that have not).

Since both Brogne and Nielsen teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message even when it has been viewed by some of the recipients as taught by Nielsen, which allows a sender to correct an error in an email in a broader range of circumstances (i.e. even when it has been viewed by some of the recipients).

Further still, Brogne and Nielsen do not explicitly disclose generating and sending a notification message to the sender and that notification

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message enabling the preclusion of e-mail access by the receipts.

However, Nielsen discloses the sender has access to the e-mail message for even after it is viewed by recipients (column 14, line 65-column 15, line 15); Nielsen simply does not explicitly state that a notification message gives the sender the means to do so.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33).

Since Brogne, Nielsen, and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message.

3. As to claim 3, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message having a text portion, the sender being allowed to modify the text portion (Brogne, column 3, lines 39-41).

4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brogne and Nielsen in view of Milewski as applied to claims 1 above, and further in view of what is well known in the art.

5. As to claim 4, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim, and further disclose the notification message for automatically accessing the e-mail message being a password (Brogne, column 5, lines 21-24).

Although, Brogne does not explicitly discloses that the password is a public key which decrypts the stored email, Official Notice is taken (MPEP 2144.04) that encrypting emails using a public key password was a well-known use of email access passwords at the time the applicant's invention was made, and is deployed to enhance security of the stored emails. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a well known practice to modify the teachings of Brogne, Nielsen and Milewski in order to achieve such benefits.

6. As to claim 5, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim 4, and further disclose the

computing system is the computing system on which the stored e-mail message was composed (Brogne, column 4, lines 12-26).

7. As to claims 6, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim 4, and further disclose the computing system is a server, the server generating and sending the notification message to the recipients and sender (Brogne, column 2, lines 12-19).

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

(1) The appellant argues with respect to the 103(a) rejection of claim 1 that Milewski fails to disclose enabling the sender of an e-mail message, using a notification message, to preclude one of the recipients that have not yet accessed the stored e-mail message from accessing the e-mail message. Specifically, the appellant contends Milewski does not appear to enable the sender to access the message. Rather, Milewski appears to disclose that the sender may only delete the message, and only a pointer message is sent to the sender of the email. Therefore, the appellant concludes neither the pointer

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message nor the status information of Milewski enables the sender to access the stored email message.

In reply to argument (1), the examiner notes arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically, Brogne was relied upon to disclose allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19, sender may modify the e-mail body, and subsequent to this intended recipients will receive the modified e-mail, obviously including those that have not already accessed the email).

Milewski was relied upon to disclose generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33).

Since Brogne, Nielsen (the second applied reference, not directly attacked by the appellant), and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the

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sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message.

Further still, the examiner contends Milewski does disclose enabling a sender to access the stored email in column 8, lines 53-64 and column 6, lines 25-33. That is, since the sender has the means and ability to delete the previously sent email, it is essential that the email message be accessed in that scenario.

For at least the above reason, claims 1 and 3-6 stand rejected.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Thomas J. Dailey

/T. J. D./

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